

R E M A R K S

Claims 1-17, 19-25, 29-31, 33-34, 38-40, 42-54 and 57-58 are in the case. The novelty of Claims 1-10, 14-17, 21, 22(15, 17, 19, 20), 29-30, 33, 38-39, 42-43, 45-46, 47(45, 46), and 48-58 is noted with sincere appreciation. Reconsideration and favorable action are respectfully requested in light of the above amendments and the following remarks.

Claim 1 has been amended to correct a clerical error; this amendment does not alter the scope of Claim 1. Claims 11 and 23 have been amended to recite a spray probe. Support for these amendments is found in the Specification on Page 4, paragraph 0014, lines 7-11. Claim 54 has been amended to include the features of Claims 55 and 56, which claims have been cancelled without prejudice or disclaimer. Entry of these amendments is requested because it is submitted that the amendments place the case in condition for allowance, or at least in better form for appeal.

Objection to the Specification

It is believed that the objection to the informality of paragraph 0001 of the Specification is cured by the above amendment, which now specifies the current status of Application No. 10/603,130.

Objections to Claim 7

An amendments has been made to Claim 7, as required in the Office Action. The amendment is believed to overcome the Examiner's objection to this claim. The amendment is clerical in nature, and does not change the scope of the Claim 7.

Rejection under 35 U.S.C. 112

The rejection under 35 USC 112 second paragraph is believed to have been withdrawn, because it is not repeated or referred to in the present Action. If this is in error, the remarks regarding this rejection made in response to the previous Office Action are reiterated here by reference.

Rejection under 35 U.S.C. 102(e)

Claims 11-13, 19, 22(11), 23-25, 31, 34, 40, 44, and 47(44) are rejected under section 102(e) as anticipated by Howarth (U.S. 6,908,636) or Howarth (U.S. 6,986,910). This rejection is respectfully traversed.

The claims as amended are submitted to be novel over both Howarth references. The explicit inclusion of a spray probe in the claims rejected hereunder is believed to render this rejection moot, as Howarth has no disclosure that inside-outside washing involves penetration of the carcass by a spray probe. Because all of the present claims include inside-outside washing with penetration of the carcass by a spray probe, all of the present claims are novel over both Howarth references.

Therefore, Claims 11-13, 19, 22(11), 23-25, 31, 34, 40, 44, and 47(44) are not anticipated by the cited references. It is respectfully requested that this rejection be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103(a) over Howarth

Claims 14-17, 20-21, 22(15, 17, 20), 29-30, 33, 38-39, 42-43, 45-46, 47(45, 46), 54-55 and 58(54, 55) are rejected under section 103(a) as obvious over Howarth (U.S. 6,908,636) or Howarth (U.S. 6,986,910). This rejection is respectfully traversed.

The rejected claims as amended are submitted to be nonobvious over both Howarth references. The explicit inclusion of a spray probe in the claims rejected hereunder is believed to render this rejection moot. Nothing in Howarth provides a motivation or suggestion to use a spray probe.

Thus, the § 103 rejection of Claims 14-17, 20-21, 22(15, 17, 20), 29-30, 33, 38-39, 42-43, 45-46, 47(45, 46), 54-55 and 58(54, 55) over Howarth should be reconsidered and withdrawn.

Rejection under 35 U.S.C. 103(a) over Howarth in view of Hilgren et al.

Claims 1-10, 48-53, 56-57, and 58(56,57) are rejected under section 103(a) as obvious over Howarth (U.S. 6,908,636) or Howarth (U.S. 6,986,910) in view of Hilgren et al. (U.S. 6,514,556). This rejection is respectfully traversed. In the following discussion, the references to Howarth are to U.S. 6,908,636.

This rejection as detailed in the previous Office Action does not point to anything in the cited references that provides a motivation or suggestion to combine these references. In an obviousness rejection, the Examiner is required to point to something in the reference that provides a motivation or suggestion to modify the reference. The Federal Circuit has stated in

In re Fritch that

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Nothing in the Howarth references has been cited in the section of the previous Office Action regarding this particular rejection. The portions of the Howarth references cited in the novelty rejection (U.S. 6,908,636, columns 2-4, 7, and 13-15 and the claims; or U.S. 6,986,910, columns 2-5, columns 10-12, and the claims) do not provide any suggestion or motivation to modify what is disclosed therein. Similarly, nothing in the cited portion of Hilgren et al. (column 17) provides a motivation or suggestion to modify the disclosure therein, much less a motivation or suggestion for combination with Howarth. Thus, a *prima facie* case of obviousness has not been established.

In response to Applicant's arguments in the Response to the previous Office Action, on Page 3 of the Final Office Action it is stated that

Hilgren et al is merely relied upon to show that applicant's use of a spray probe is conventional in treating eviscerated poultry carcasses with a microbiocidal solution, regardless of whether or not Hilgren et al uses the same solution as applicant or the Howarth patents.

However, a reference must be considered in its entirety, i.e., as a *whole*, including portions that would lead away from the invention; elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents. *Panduit v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1529 (Fed. Cir. 1988), citations omitted; emphasis in original. In other words, a reference may not be cited to show a feature of the claimed invention while ignoring portions of the reference that discourage combination with other cited references. Thus, the citation of Hilgren et al. in combination with Howarth is believed to be improper.

Furthermore, as noted in the response to the previous Office Action, Hilgren et al. teaches away from the use of chlorinated biocides, stating that

[T]he use rate of these antimicrobials is very high because they are not effective at low concentrations or they tend to be rapidly consumed by the high organic load included with the poultry. Excessive chlorination of food processing water with hypochlorite has prompted concern over production of toxic or carcinogenic organochlorine compounds and other by-products. (Hilgren et al., column 2, lines 20-30.)

From this passage, it is clear that Hilgren et al. discourages the use of chlorine-based biocides. In contrast, Howarth teaches the use of chlorinated biocides, including chlorine, 1,3-dichloro-5,5-dialkylhydantoins, and 1,3-bromochloro-5,5-dialkylhydantoins, (column 2, line 47 to column 3, line 4). These teachings are contradictory, and it is thus submitted that the cited references teach away from their combination.

Further underscoring the nonobviousness of the present invention, Hilgren et al. is silent regarding brominated biocides, while Howarth does not teach or suggest that inside-outside washing involves penetration of the carcass by a spray probe, both of which features are required by the present claims.

Dependent Claims 9, 10(9), 17, 21, 29, 33, 34(33), 38, 42, 43, 46, and 47(46) involve the feature that the water applied to the interior cavity has been treated with a higher concentration of the 1,3-dibromo-5,5-dialkylhydantoin than that with which the water applied to the exterior of the carcass has been treated in conjunction with penetration of the interior cavity of a carcass by a spray probe. There is no teaching or suggestion in either Howarth or Hilgren et al. that a different degree of sanitization would be needed for the interior as compared to the exterior. The portion of Howarth that teaches washing of the birds inside and out (column 35, lines 51-58) uses the *same* concentration of 1,3-dibromo-5,5-dimethylhydantoin for all of the washing. Similarly, the portion of Hilgren et al. that teaches inside-outside bird washing indicates only one concentration range for all of the washing therein (column 17, lines 47-54). Much as there is no teaching in either reference of a higher concentration of biocide for the interior cavity, there is also no teaching in either reference that a *lower* concentration of biocide than that used for the interior is sufficient for sanitizing the exterior of the carcass in either cited reference. Thus, even if the cited combination of references were proper, Claims 9, 10(9), 17, 21, 29, 33, 34(33), 38, 42, 43, 46, and 47(46) would not have been obvious to one of ordinary skill in the art.

In summary, the § 103 rejection of present Claims 1-10, 48-53, 56-57, and 58(56,57) over the combination of either Howarth patent with Hilgren et al. should be reconsidered and withdrawn.

In light of the foregoing amendments and remarks, the case is believed to be in condition for allowance. Prompt notification to this effect would be sincerely appreciated.

If, however, any matters remain requiring further consideration, the Examiner is respectfully requested to telephone the undersigned so that such matters can be discussed, and if possible, promptly resolved.

Respectfully submitted,

/Mary H. Drabnis/

Mary H. Drabnis
Reg. No. 45,909
Sieberth & Patty, LLC
4703 Bluebonnet Boulevard
Baton Rouge, LA 70809
Telephone: 225-291-4600
Facsimile: 225-291-4606